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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/673,412	11/22/2000	Moshc Baru	107587	8564

25944 7590 03/27/2002

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EXAMINER

SCHNIZER, HOLLY G

ART UNIT	PAPER NUMBER
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1653

DATE MAILED: 03/27/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

FILE COPY
Application No.
09/678,112

Office Action Summary

Applicant(s)
BARU ET AL.

Examiner
Holly Schnizer

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1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-19 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-13, drawn to a compositions comprising Factor VIII (FVIII) and substantially neutral colloidal particles, wherein the FVIII is not encapsulated in the colloidal particle.

Group II, claim(s) 14-15, drawn to a method of treatment using the FVIII and neutral colloidal particle composition.

Group III, claim(s) 16-17, drawn to a method of making a composition comprising FVIII and a neutral colloidal particle using the colloidal particle.

Group IV, claim(s) 18, drawn to a composition comprising a protein and a neutral colloidal particle, wherein the protein is not encapsulated in the neutral colloidal particle.

Group V, claim(s) 19, drawn to a method of making a composition comprising a protein and a neutral colloidal particle using the colloidal particle.

The inventions listed as Groups I-V do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The technical feature linking Groups I-V appears to be that they all relate to a composition comprising a protein and a neutral colloidal particle wherein the protein is not encapsulated within the colloidal particle.

However, Woodle et al. (US Patent No. 5,013,556; referenced in IDS of Paper No. 5) teaches a composition comprising a protein and a neutral colloidal particle, the particle comprising 1-20 mole percent of an amphipathic lipid (phosphatidylethanolamine) derivatized with a biocompatible hydrophilic polymer (polyethylene glycol) (see

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abstract). And, Woodle et al. teaches that the protein may be factor VIII (Col. 12, line 17) and that the protein may be coupled to the surface of the liposome (Col. 12, lines 4-68). Woodle et al. teach that the liposome compositions described therein provide enhancement of blood circulation lifetime (Col. 13, lines 28-30).

Therefore, the technical feature linking the inventions of Groups I-V does not constitute a special technical feature as defined by PCT Rule 13.2, as it does not define a contribution over the prior art.

The special technical feature of Group I is considered to be a composition comprising FVIII and a neutral colloidal particle wherein FVIII is not encapsulated in the particle.

The special technical feature of Group II is considered to be a method of treating hemophilia using a composition comprising FVIII and a neutral colloidal particle.

The special technical feature of Group III is considered to be a method of making a composition comprising FVIII and a neutral colloidal particle.

The special technical feature of Group IV is considered to be a composition comprising any protein and a neutral colloidal particle, wherein the protein is not encapsulated in the particle.

The special technical feature of Group V is considered to be a method of making a composition comprising any protein and a neutral colloidal particle.

Accordingly, Groups I-V are not so linked by the same or a corresponding special technical feature so as to form a single general inventive concept.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim


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remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Holly Schnizer whose telephone number is (703) 305-3722. The examiner can normally be reached on Mon. & Thurs., 8am-5:30pm and Tues. & Wed. 9-2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on (703) 308-2923. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.


Holly Schnizer
March 25, 2002


CHRISTOPHER S. F. LOW
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600